

2132

PATENT
Customer Number 22,852
Attorney Docket No. 07451.0001.18
InterTrust Ref. No.: IT-5.2.1.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Karl L. GINTER et al.) Group Art Unit: 2132
)
Serial No.: 09/870,801) Examiner: G. Barron, Jr.
)
Filed: June 1, 2001)
)
For: SYSTEMS AND METHODS FOR)
SECURE TRANSACTION)
MANAGEMENT AND)
ELECTRONIC RIGHTS)
PROTECTION)

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Commissioner for Patents
Washington, DC 20231

Sir:

NOTICE REGARDING RELATED LITIGATION

Applicants hereby notify the U.S. Patent and Trademark Office that several patents assigned to InterTrust Technologies Corporation ("InterTrust") are involved in litigation. The present application, Serial No. 09/870,801, is a continuation of U.S. Application Serial No. 09/342,899, issued as U.S. Patent No. 5,917,912, which is one of the patents at issue in the litigation. Those applications claim the benefit of priority of a common parent with U.S. Patent Nos. 6,389,402 B1; 6,253,193 B1; 6,185,683 B1; 5,982,891; 5,949,876; 5,915,019; and 5,892,900, which are also at issue in the litigation.

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STATUS OF RELATED LITIGATION

The status of the litigation is as follows. On April 26, 2001, InterTrust filed a Complaint alleging that Microsoft Corporation ("Microsoft") was infringing U.S. Patent No. 6,185,683 B1, assigned to InterTrust. See *InterTrust Tech. Corp. v. Microsoft Corp.* (C 01-1640 SBA, N. D. Ca.). A copy of the Complaint is attached as Exhibit A. On June 26, 2001 and July 26, 2001, InterTrust amended its complaint to add U.S. Patent Nos. 6,253,193 B1; 5,920,861; and 5,940,504.¹ See Exhibit B.

On August 29, 2001, Microsoft filed its Answer to InterTrust's Second Amended Complaint. See Exhibit C. On September 17, 2001, Microsoft filed a First Amended Answer and Counterclaims, asserting twelve affirmative defenses, including, *inter alia*, non-infringement, invalidity, dedication to the public, prosecution history estoppel, and inequitable conduct, and counterclaiming for declaratory judgments of non-infringement and invalidity of the InterTrust patents, and for infringement of U.S. Patent Nos. 6,049,671 and 6,256,668 B1, allegedly assigned to Microsoft. See Exhibit D.

On October 26, 2001, InterTrust filed a Third Amended Complaint to add U.S. Patent Nos. 5,917,912; 5,892,900; and 5,982,891. See Exhibit E. Microsoft filed its Answer and Counterclaims to InterTrust's Third Amended Complaint on November 8, 2001, *see* Exhibit F, and filed an Amended Answer and a "Corrected" Amended Answer on November 14 and 15, respectively, *see* Exhibits G and H, asserting several additional affirmative defenses and counterclaims. *See, e.g., id.* at pages 9 and 13-19.

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¹ The '504 patent was subsequently dismissed from this suit.

On February 6, 2002, InterTrust filed a second lawsuit against Microsoft, alleging infringement of U.S. Patent No. 6,157,721 ("the '721 patent"). *See* Exhibit I.² Microsoft filed its Answer and Counterclaims on March 25, 2002, and filed a First Amended Answer and Counterclaims on April 12, 2002, asserting thirteen affirmative defenses, including, *inter alia*, non-infringement, invalidity, dedication to the public, prosecution history estoppel, inequitable conduct, and unenforceability, and counterclaiming for declaratory judgment of non-infringement and invalidity. *See* Exhibit J. On June 5, 2002, Microsoft served its Initial Disclosures Pursuant to Fed. R. Civ. P. 26(a)(1), identifying various technologies believed by Microsoft to bear on the validity of the '721 patent. *See* Exhibit K.

On July 30, 2002, InterTrust filed a motion for leave to file a Fourth Amended Complaint, adding claims of infringement of additional InterTrust patents. This motion was granted on October 22, 2002. The Fourth Amended Complaint was filed on October 24, 2002, adding to the case claims of infringement of U.S. Patent Nos. 6,112,181; 5,915,019; 5,949,876; and 6,389,402 B1. *See* Exhibit L.

On August 16, 2002, Microsoft served its Preliminary Invalidity Contentions Regarding U.S. Patent Nos. 6,253,193 B1 and 6,185,683 B1 ("Preliminary Invalidity Contentions"). *See* Exhibit M. In its Preliminary Invalidity Contentions, Microsoft asserts that certain claims in those patents are indefinite, lack enablement, and lack an adequate written description. Microsoft also asserts that certain claims are anticipated or rendered obvious by various references. *See id.* at pages 3-7.

² This case has since been consolidated with the case filed April 26, 2001.

REMARKS

In support of its claim that InterTrust's U.S. Patent Nos. 5,892,900; 5,920,861; and 6,157,721 are unenforceable, Microsoft cites three references: (1) an article entitled DigiBox: A Self-Protecting Container for Information Commerce, by Olin Sibert et al. ("the Sibert article"); (2) PCT Publication No. WO 96/27155 ("the PCT Publication"); and (3) U.S. Patent No. 5,910,987 ("the '987 patent"). Applicants note that the Sibert article was cited in connection with the present application in an IDS filed November 13, 2001. Applicants also note that the PCT Publication is the international counterpart of U.S. Application No. 08/388,107 ("the '107 application"), a parent of the present application, and that the '987 patent is a continuation of the '107 application.

If there are any fees due with the filing of this Notice not already accounted for, please charge the fees to our Deposit Account No. 06-0916

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

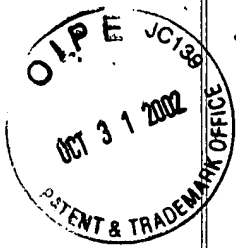
Dated: October 30, 2002

By: 

Karna J. Nisewaner
Reg. No. 50,665

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INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicants bring to the attention of the Examiner the documents listed on the attached Form PTO 1449. This Information Disclosure Statement is being filed, to the best of the undersigned's knowledge, before the mailing date of a first Office Action on the merits for the above-referenced application. Applicants also submit herewith copies of the listed documents.

The documents cited herein were cited by Microsoft in the InterTrust Tech. Corp. v. Microsoft Corp. litigation (C 01-1640 SBA, N. D. Ca.), which involves patents related to this patent application. See Notice Regarding Related Litigation, filed concurrently herewith. Some or all of these documents may have been previously cited in other Information Disclosure Statements filed in this application to which those applications

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claim priority under 35 U.S.C. §120. However, out of an abundance of caution, Applicants are bringing these documents to the Examiner's attention along with the additional information that these documents have been mentioned in the litigation. Applicants respectfully request that the Examiner consider the listed references and indicate that they were considered by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicants determine that the cited documents do not constitute "prior art" under United States law, Applicants reserve the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

Applicants further reserve the right to take appropriate action to establish the patentability of the claimed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

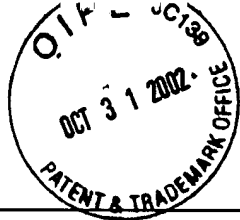
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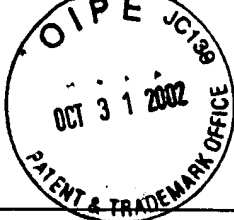


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Atty. Docket No.	07451.0001-18000	Appln. No.	09/870,801
Applicant	Karl L. Ginter, et al.		
Filing Date	June 1, 2001	Group:	2132

	Chaum, D., et al. "Wallet databases with observers," Ernest F. Brickell, editor, Advances in Cryptology - CRYPTO '92, 12 th Annual International Cryptology Conference, Santa Barbara, CA, August 16-20, 1992, Proceedings, pp. 89-105.
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	Olivier, MS, et al., "Building a Secure Database using Self-protecting Objects," Computers & Security, Vol. 11, No. 3, 259-271, 1992.
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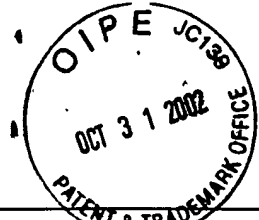


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	Coalition for Networked Information, Interactive Multimedia Association, John F. Kennedy School of Government, "Proceedings: Technological Strategies for Protecting Intellectual Property in the Networked Multimedia Environment," 1994, Journal of the Interactive Multimedia Association, available at < http://www.cni.org/docs/ima.ip-workshop >, 308 pages.
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Examiner	Date Considered
*Examiner:	Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce



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Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate
	4,658,093	04-14-87	Hellman	380	25	07-11-83
	5,530,235	06-25-96	Stefik, et al.	235	492	02-16-95
	5,534,975	07-09-96	Stefik, et al.	355	202	05-26-95
	5,603,031	02-11-97	White et al.	395	683	07-08-93
	5,629,980	05-13-97	Stefik, et al.	380	4	11-23-94
	5,634,012	05-27-97	Stefik, et al.	395	239	11-23-94
	5,638,443	06-10-97	Stefik, et al.	380	4	11-23-94
	5,715,403	02-03-98	Stefik	395	244	11-23-94
	6,016,393	01-18-00	White, et al.	395	683	02-10-97

Examiner Initial*	Document Number	Publication Date	Country	Class	Sub Class	Translation Yes or No
	WO 93/01550	01-21-93	PCT	G06F	11/34	
	EP 0715243 A1	06-05-96	EPO	G06F	1/00	
	EP 0715244 A1	06-05-96	EPO	G06F	1/00	
	EP 0715245 A1	06-05-96	EPO	G06F	1/00	
	EP 0715246 A1	06-05-96	EPO	G06F	1/00	
	EP 0715247 A1	06-05-96	EPO	G06F	1/00	

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Examiner Initial*	OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)
	Abadi, M., et al., "Authentication and Delegation with Smart-cards," Technical Report 67, DEC Systems Research Center, October 1990, available at < http://citeseer.nj.nec.com/article/abadi92authentication.html >, pp. 1-19.
	Blaze, M., "A Cryptographic File System for Unix," pre-print of paper for First ACM Conference on Computer and Communications Security, Fairfax, Virginia, Nov. 3-5, 1993, pp. 1-8.
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